

# REMARKS/ARGUMENTS

1           Claims 1 to 35 remain in this application. Claims 1 and 27  
2 are independent; and the remaining claims are dependent, either  
3 directly or through one another, upon these claims. Independent  
4 Claim 1 has been amended.

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6           In the Office Action, Page 1, the Office Action summary page  
7 indicated that Claims 27 to 35 were allowed, and that Claims 8 to  
8 14 and 16 to 22 were objected to. This also was summarized on Page  
9 6 of the Office Action under the heading "Allowable Subject  
10 Matter". Here, it was stated that Claims 8 to 14 and 16 to 22 were  
11 objected to but would be allowed if rewritten in independent form.  
12 Claims 27 to 35 were allowed. These statements, found in these two  
13 places in the Office Action, are partially in conflict with the  
14 statement of rejection found on Page 2, Paragraph 1, under the  
15 heading "Claim rejections 35 U.S.C. §102". Here, it was stated  
16 that Claims 27,28,31,33 and 35 were rejected (along with other  
17 claims) as anticipated by the patent to Link.  
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20           In view of the fact that Claims 27 through 35 were indicated  
21 as allowable on Page 1 and Page 6 of the Office Action by an  
22 explicit identification to that effect, applicant is considering  
23 the mention of these claims under a rejection on Page 2 to be  
24 erroneous. Consequently, the subsequent discussion of various  
25 rejections of claims in the application will omit any discussion of  
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1 claims 27 to 35, since these claims are considered allowed as  
2 filed.

3 Claim 1 was rejected under 35 U.S.C. §112 as being indefinite.  
4 Specifically, the Examiner noted the limitation of the distance of  
5 the extension of the auxiliary plate as being unclear, since the  
6 predetermined distance was not determined or given. Claim 1 has  
7 been amended to state that the predetermined distance is a fraction  
8 of the distance between the lower and upper edges of the main plate  
9 member. Applicant respectfully submits that this definition  
10 clearly establishes the predetermined distance in terms of precise  
11 parameters. Applicant further respectfully submits that this  
12 amendment to Claim 1 also clearly causes Claim 1 to distinguish  
13 over all of the prior art which was cited against this claim in the  
14 various rejections made.  
15

16 All of the other rejected claims in this application are  
17 dependent, either directly or through one another, upon Claim 1.  
18 Applicant respectfully submits this limitation in Claim 1 which  
19 clearly establishes the "predetermined distance" parameters,  
20 necessarily carries on into all of the dependent claims.  
21 Consequently, all of the claims which currently are under rejection  
22 in this application now are considered to be allowable.  
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24 Claims 1 to 4, 15, 24, and 25 were rejected under 35 U.S.C.  
25 §102(b) as anticipated by the United States patent to Link No.  
26

3,643,827. Claims 1 to 5 were rejected under 35 U.S.C. §102(b) as anticipated by the United States patent to Carson No. 4,175,903. In addition, Claims 1 to 5 were rejected under 35 U.S.C. §102(b) as anticipated by the United States patent to Ehmann No. RE23,694. Claim 6 was rejected under 35 U.S.C. §103(a) as unpatentable over Carson; and Claims 7 and 23 were rejected under 35 U.S.C. §103(a) as unpatentable over Carson in view of the United States patent to Jordan No. 3,433,376.

The following discussion of the rejections of these various claims is being made on the basis of Claim 1 as currently amended. As noted above, all of the other rejected claims are dependent, either directly or through one another, upon independent Claim 1.

Applicant respectfully submits that for a claim to be rejected for a lack of novelty under §102(b), the reference(s) must disclose every limitation recited in the rejected claim (or claims). As stated in MPEP §2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

*Verdegaal Bros. v. Union Oil Co. of California*, 814 F2nd 628, 631, 2 USPQ 2<sup>nd</sup> 1051, 1053 (Fed. Cir. 1987) states: "The identical invention must be shown in as complete detail as is contained in the... claim."

*Richardson v. Suzuki Motor Co.*, 868 F2nd 1226, 1236, 9 USPQ 2<sup>nd</sup>

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1 1913, 1920 (Fed. Cir. 1989) states: "The elements must be arranged  
2 as required by the claim..."

3 Applicant respectfully traverses all three of the rejections  
4 under 35 U.S.C. §102(b) of Claims 1 to 5, 15, 24 and 25 as  
5 anticipated by the Link patent No. 3,643,827 or Claims 1 to 5 as  
6 anticipated by the Carson patent No. 4,175,903, or of Claims 1 to  
7 5 as anticipated by the Ehmann patent No. 2,674,387.

8 With respect to Link, the Examiner has taken the position that  
9 Link discloses a main plate with an auxiliary plate (70 and 80)  
10 overlying it and extending from the lower edge of the main plate  
11 substantially toward the upper edge of the main plate... and a  
12 yieldable frictionable material (140) over substantially the major  
13 portions of the auxiliary plate and the portion of the main plate  
14 not covered by the auxiliary plate. The elements which the  
15 Examiner is calling an auxiliary plate in Link are the frame  
16 elements, which are attached to the lift truck mechanism, and which  
17 then are attached to the outside surfaces of the main plate 78.  
18

19 The only surfaces in Link which are covered with yieldable  
20 friction material are the inner or facing surfaces of the main  
21 plates 78; and these surfaces are covered from top to bottom. This  
22 is a standard structure for clamping plate mechanisms in existence  
23 prior to applicant's invention. There is no friction material  
24 covering any portion of the support frame members 70 and 80.  
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1 Applicant respectfully submits that these are not an auxiliary  
2 plate oriented and dimensioned as specifically recited in  
3 independent Claim 1. The yieldable friction material 140 covers  
4 the facing surfaces of the clamping plates 78. Where is there any  
5 yieldable material on any surface of the elements 70 or 80 of Link?  
6 There is none. The other specific relationships of elements  
7 recited in Claim 1 also are not present in Link.

8 Claims 1 to 5 have been rejected as anticipated under 35  
9 U.S.C. §102(b) by Carson. Carson is directed to a clamping  
10 assembly including elongated frames 35, which hold clamping pads 29  
11 on them. These pads are attached to a base plate 28, which in turn  
12 is attached to a support arm 35. The manner in which the portion  
13 called the base plate 28 is attached to the arm 35 is not well  
14 illustrated, and is not clear from the Carson drawings. It is  
15 clear, however, that the entire facing surface of the clamping arms  
16 is a single surface covered with yieldable friction material. The  
17 facing surfaces do not include a main plate member with an  
18 auxiliary plate extending a predetermined distance from the bottom  
19 edge to the upper edge of the main plate where the predetermined  
20 distance is a fraction of the distance between the lower and upper  
21 edges of the main plate member. There is nothing like this in  
22 Carson.  
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25 Claims 1 to 5 have been rejected under 35 U.S.C. §102(b) as  
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1 anticipated by the United States patent to Ehmann No. RE23,694 .  
2 The Examiner has taken the position that Ehmann discloses clamping  
3 plates comprising a main plate (31b) with an auxiliary plate (80)  
4 overlying the main plate with yieldable friction material 77 over  
5 substantially the major portions of the auxiliary plate and the  
6 portion of the main plate not covered by the auxiliary plate.

7 The device disclosed in the Ehmann patent is very similar to  
8 the one disclosed in Carson. A pair of extending clamping arms 31  
9 are located on opposite sides of the device for movement toward and  
10 away from one another to clamp onto the sides of objects to be  
11 lifted and moved. In one version, the arms, such as 31A of Figure  
12 7, have a perforated rubber pad on their facing surfaces extending  
13 essentially from front to back and top to bottom. Ehmann then  
14 states (for Figure 8) that the arm 31B is covered with a steel  
15 plate 80 equipped with spikes 81. These are used in place of the  
16 rubber cushion 77 of the version shown in Figure 7. Element 80 is  
17 not an auxiliary plate. It is a substitution for the plate of  
18 Figure 7, which is covered with a rubber cushion 77. Where in  
19 Ehmann is the relationship between an auxiliary plate and a main  
20 plate, with the auxiliary plate extending a predetermined distance  
21 from the lower edge of the main plate to the upper edge thereof  
22 where the predetermined distance is a fraction of the distance  
23 between the lower and upper edges of the main plate member?  
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Nothing like this is present in Ehmann.

Since the elements discussed in the previous paragraphs are not present in Link, Carson or Ehmann, the rejections of independent Claim 1 (and dependent Claims 2 to 7, 15 and 23 to 26) under 35 U.S.C. §102(b) are unsupported and should be withdrawn. Since there is no support for these rejections of independent Claim 1, applicant respectfully submits there also is no support for the rejections under 35 U.S.C. §102(b) of any of the claims dependent upon Claim 1.

The only rejections of Claims 1 to 5, 15 and 24 to 26 are of anticipation under 35 U.S.C. §102(b) by the Link, Carson and Ehmann patents. Applicant respectfully submits that, contrary to the Examiner's position that all of the elements of the various claims are disclosed by these references, the rejections of these claims clearly are unsupported, as detailed above. The rejections of Claims 1 to 5, 15 and 24 to 26 consequently are traversed as being improper and failing to meet the clear requirements of MPEP §2131.

Applicant respectfully requests the withdrawal of the rejection of these claims as anticipated and respectfully requests allowance of these claims.

Claim 6 was rejected under 35 U.S.C. §103(a) as unpatentable over Carson. As the basis for this rejection, the Examiner has stated that Carson discloses spaced grooves parallel to the lower

1 and upper edges of the main plate. The Examiner admits that Carson  
2 does not disclose the thickness of the grooves or the thickness  
3 between the grooves. The Examiner has stated that it would have  
4 been obvious to one of ordinary skill in the art to provide grooves  
5 to have at least 1 and 1/4" between them to frictionally engage the  
6 surface of an object to be lifted without too great of slippage in  
7 holding the object by friction. Where, absent applicant's own  
8 disclosure and the recitation of Claim 6 itself, does the Examiner  
9 find any support whatsoever for this conclusion in Carson?  
10 Applicant further submits that other elements of Claim 6 (which is  
11 dependent upon Claim 1 through other claims) also are not present  
12 in Carson, as discussed above.  
13

14 As specified in MPEP §2142, in order to properly combine (or  
15 modify) references under 35 U.S.C. §103, "The Examiner must step  
16 backward in time and into the shoes worn by the 'hypothetical  
17 person of ordinary skill in the art' when the invention was unknown  
18 and just before it was made." To do this, the Examiner must put  
19 aside knowledge of an applicant's own disclosure and refrain from  
20 using hindsight to reach the legal conclusion based on facts  
21 gleaned from the prior art.  
22

23 Further as set forth in MPEP §2142, in order to establish a  
24 prima facie case of obviousness under 35 U.S.C. §103, there must be  
25 some suggestion or motivation, either in the references themselves  
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1 or in the knowledge generally available to one of ordinary skill in  
2 the art to combine (or modify) the reference teachings. In  
3 addition, the teaching or suggestion to make the claimed  
4 combination (modification), and the reasonable expectation of  
5 success, must both be found in the prior art and not be based on  
6 applicant's disclosure. Various cases in support of this are set  
7 forth in MPEP §2142; and for that reason, those cases will not  
8 further be cited here.

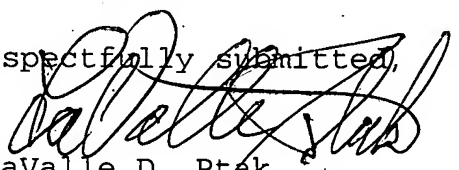
9 In addition to the foregoing, MPEP §2143.01 clearly sets forth  
10 that the mere fact that references can be combined or modified does  
11 not render the resultant obvious, unless the prior art also  
12 suggests the desirability of such a combination. Applicant  
13 respectfully submits that this requirement clearly is absent in the  
14 modification of Carson. Where, absent applicant's own disclosure,  
15 does the Examiner find anything in Carson which would suggest the  
16 specific recitations found in Claim 6? The Examiner has admitted  
17 as much, stating that Carson does not disclose the thickness of the  
18 grooves or the thickness between the grooves. Where then is there  
19 a suggestion for the specific modification which has been made of  
20 Carson in order to reject Claim 6 under 35 U.S.C. §103? Applicant  
21 respectfully submits that the rejection of Claim 6 as unpatentable  
22 over Carson under 35 U.S.C. §103(a) is improper; and applicant  
23 respectfully requests withdrawal of this rejection.  
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1 Claims 7 and 23 were rejected under 35 U.S.C. §103(a) as  
2 unpatentable over Carson in view of the patent to Jordan. As  
3 stated by the Examiner, Jordan discloses a clamping device where  
4 the portions 40 and 46 are manufactured from aluminum. Claims 7  
5 and 23, however, are dependent, either directly or through other  
6 claims, upon independent Claim 1. Carson and Jordan, even they are  
7 to be combined in some manner which even may be as suggested by the  
8 Examiner, fail to even remotely suggest the other elements present  
9 in the claims upon which they are dependent. As a consequence,  
10 even if a combination of these two patents were to be made, the  
11 resultant wholly fails to be a structure of the type which is  
12 present in these two dependent claims.  
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14 In view of the foregoing, applicant respectfully submits that  
15 all of the claims in this application are in condition for  
16 allowance. This includes rejected Claims 1 to 7, 15, 23 to 26, as  
17 well as previously allowed Claims 27 to 35 and Claims 8 to 14 and  
18 16 to 22. Consequently, withdrawal of the various rejections of  
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1 Claims 1 to 7, 15 and 23 to 26 is respectfully requested; and  
2 allowance of all of the claims is respectfully solicited.

3 Respectfully submitted,

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11 Date: 6/23/05  
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